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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,779

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Thienna Ho

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,779	Applicant(s) HO, THIENNA	
	Examiner GINA C. YU	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/9/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a person in need of a lighter skin tone", which renders the claim vague and indefinite. Examiner is of opinion that whether a lighter skin tone is needed is an individual's subjective decision. The scope of the population limitation is not clear because whether an individual who intakes a prior art methyl sulfonyl methane is "in need of a lighter skin tone" cannot be objectively determined.

The remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Herschler (US 4296130).

Claim 1 recites a method for lightening the natural skin color of a user. When a claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. See In re May, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). In this case, Herschler anticipates claim 1 since the claimed use of the prior art composition to lighten the skin is directed to the result and property of the composition.

Herschler discloses an aqueous solution comprising 10 % by weight of methyl sulfonyl methane (MSM). The reference also teaches in col. 2, lines 18 – 68 that MSM is a naturally occurring substance, and beautifies the complexion of the skin when applied topically. The reference teaches that the composition can be in solution, cream, lotion or gel for topical administration or oral administration, depending on its intended use. See col. 2, lines 41 – 46. See instant claims 1 and 2.

It is noted that the reference is silent as to the skin lightening property of MSM compound and the composition comprising thereof. However, since the prior art teaches the same compound, the recited property of the MSM is necessarily present in the prior art. Also, since a chemical composition and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claims 1, 4, 5, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuhnau (US 2002/0142019 A1).

Kuhnau discloses a cosmetic composition comprising 5 % by weight of MSM and vitamin C (ascorbyl palmitate) and vitamin E. See [0046], Example 1; instant claims 1,

4, and 7. The reference teaches that the composition is made in the form of lotion, creams, oils, and gels. See [0034] and [0039]. See instant claims 2 and 5.

Since the prior art teaches the same compound, the recited skin lightening property of the MSM is necessarily present in the prior art. Also, since a chemical composition and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada.

Kuhnau teaches topically applying the same composition that is used by applicants. See [0009]-[0010]. When a claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. See In re May. Claim 1 is anticipated since the claimed use of the prior art composition to lighten the skin is directed to the result and the property of the composition.

Claims 1, and 5, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott (US 6183758 B1).

Scott discloses a skin cream comprising 0.7 % of MSM, which, given the broadest interpretation of the claim limitation, is within the claimed range of "approximately 1-20 weight percent". See Example: instant claims 1 and 5. The composition also comprises vitamin E and fragrance. See instant claims 6 and 7.

Since the prior art teaches the same compound, the recited skin-lightening property of the MSM is necessarily present in the prior art. Also, since a chemical composition

and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada.

Scott teaches topically applying the same composition that is used by applicants. When a claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated. See In re May. In this case, the reference anticipates claim 10 since the claimed use of the prior art composition to lighten the skin is directed to the result and the property of the composition.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Charter et al. (US 6541045 B1) ("Charter").

Charter discloses a tablet comprising 400 mg of MSM and magnesium (a mineral). See comparative example 1. Since the prior art teaches the same compound, the recited skin-lightening property of the MSM is necessarily present in the prior art. Also, since a chemical composition and its properties are inseparable, the prior art composition also has the same skin lightening property. See In re Spada.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 11, 12, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herschler (US 4296130) as applied to claims 1-7, 10 as above, and further in view of Kirby et al. (US 6444234 B1).

Herschler also teaches 15% MSM composition and further teaches that greater amount of MSM could be used if the composition is heated and mixed prior to topical application. See col. 5, lines 34- 38; instant claims 9-11. Since the reference teaches the efficacy of MSM in beautifying skin, finding an optimal daily oral dosage of MSM would have been obvious is also obvious to one of ordinary skill in the art.

While Herschler teaches making topical formulations comprising MSM, the reference fails to teach transdermal patch.

Kirby discloses a transdermal delivery system of pharmaceutical agents including MSM. See Tables and Examples.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the Herschler method of administering MSM by formulating a transdermal patch as motivated by Kirby because the latter teaches a rapid and non-irritating transdermal delivery of pharmaceutically active agents. The skilled artisan would have had a reasonable expectation of successfully administering MSM in a rapid and safe route.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herschler (US 4296130) as applied to claims 1-7, 10 as above, and further in view of Flick (Cosmetic and Toiletry Formulations, vol. 6).

While Herschler teaches that administering MSM to a subject softens the skin and beautify the complexion, the reference fails to teach adding an exfoliate.

Flick teaches glycolic acid skin rejuvenating cream.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the Herschler method of administering MSM by incorporating to the topical composition an exfoliate such as glycolic acid as motivated by Flick because both references teach skin treatment compositions which beautify the skin and Flick specifically teaches rejuvenating function of glycolic acid. The skilled artisan would have had a reasonable expectation of successfully producing formulating a transdermal patch as motivated by Kirby because the latter teaches a rapid and non-irritating transdermal delivery of pharmaceutically active agents. The skilled artisan would have had a reasonable expectation of successfully administering MSM in a rapid and safe route.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Gina Yu/
Patent Examiner